APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,908	11/28/2000	Casey J. Pelkey	723-987	7830

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EXAMINER
HOTALING, JOHN M

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>26 August 2004</u>.

2a) ☒ This action is **FINAL.**   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-51</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-51</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☐ All b) ☐ Some * c) ☐ None of:

       1. ☐ Certified copies of the priority documents have been received.

       2. ☐ Certified copies of the priority documents have been received in Application No. _____.

       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
     Paper No(s)/Mail Date _____ .

4) ☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____ .

DETAILED ACTION

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over

First Internet Backgammon Server 1994 (FIBS) in view of Instant Messaging Guide

1996 (1MG) in view of US Patent No. 5,960,173 to Tang et al. (Tang) and Darling WO

93/231,125. In re claims, 1-3, and 29-30, FIBS teaches an Internet connected server

(Pg. 1, What is FIBS?), a plurality of people connecting to the Internet server indicating

at least two video game systems configured to connect (Pg. 1, What is FIBS?),

communicating status data of activity through watching plays (Pg. 2, Player status),

session data on status of users concerning their ratings and availability (Pg. 2, Player

status), and the session data is available to anyone logged into the system regardless

of game play. FIBS does not teach creating user defined buddy lists or that the gaming

machine may be a portable hand held device with a removable memory. 1MG teaches

creating user definable buddy lists so that a user can easily ascertain whether a defined

user is available (Pg. 3). FIBS and 1MG are related in that both facilitate network

realtime messaging between available users. 1MG is an updated chatting program

having features that are highly desirable to most- users attempting to use real-time

chatting~ therefore providing motivation to include these features in FIBS. Tang is

further evidence that monitoring users on different computer using different applications

was well known in conjunction with providing user communication. Tang teaches a

networked computer system that monitors a plurality of users engaged in various

computer activities and provides current user status to all those involved in the various

computer activities (Abstract). Tang's system provides a desirable mechanism as a way

for people to initiate a conversation or other encounters with which they would like to

interact (2:36-39). Tang also teaches tracks and allows users to be engaged in various

different computer programs (3:46-50), is updated as to show current user engagement

(4:55-59), provides a visual or other cue to users of the system that people are available

or unavailable *(4:59-64),* workers could be connecting and accessing various web

computers (5:12-59), users can control the degree of monitoring the system can employ

(7:1-14), the users can communicate via text messaging (8:1.3), a user can control

his/her own availability to other users (12:62-13:9), and users and predefined lists are

defined by those belonging to a group (2:28-39). In an analogous game machine to

Darling therein is disclosed a computer game system and a multiplayer wireless

communication device that includes some degree of direct communication between

players as well as system wide communication where a player may select from a menu

of predetermined messages or may type in a message. Page 8 discloses that the unit

could be a Nintendo Gameboy or Sega Game Gear with a memory device and a

communications unit, a wireless hand held unit (in re claims 14,15,32,33). Page 9

discloses that at least some degree of communication may be provided between

players within a game playing group. Depending upon the input capabilities of the

game machine, a message intended for another player may be selected from a menu of predefined messages or typing in on a keyboard. Also, a particular accomplishment of one player may result in a message being transmitted to all of the other game machines in the game playing group. Page 17 discloses that any suitable communications protocol known to those of skill in the art may be used. Darling discloses on pages 20 and 21 that the messages may be transferred to game machines made by different companies. One would be motivated to use the features taught by Tang because the system is a desirable mechanism for network communication. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify FIBS to include a user definable buddy list as taught by 1MG so that a user can easily and quickly determine is their buddies are available and modify FIBS in view of 1MG to use the system taught by Tang and Darling so that the existing game communication is enhanced with other known desirable features in a network communication system.

In re claim 2, FIBS teaches indicating status data of whether a player is online (Pg. 2, Player status) and where the ability to send and receive message is inherent once online.

In re claims 3 and 31, FIBS teaches indicating status data of whether a player is online (Pg. 2, Player status) and setting an indicator of status to 'not ready', which indicates a player is online, but not ready to communicate or play a game.

In re claim 4, 1MG discloses Internet chatting programs and their features, where a user can customize a message to indicate anything the users wants to share with other users (Page 2, Message Central).

In re claim 5, FIBS teaches storing player profiles as rating, experience, and game drop ratings (Pg. 2, Player status; Pg. 3, Droppers).

In re claims 6 and 19, FIBS in view of 1MG teaches blocking access to a users profile as one of the message indicators (Page 2, Features).

In re claim 7, FIBS teaches an administrator blocking a user's access effectively affecting the accessibility of a user profile.

In re claim 8, FIBS in view of 1MG in view of Tang teach the claimed limitations as discussed above, but do not teach communicating to a user the buddy list memberships a user is active in. 1MG teaches providing security measures to let users know what buddy lists they belong to through authorization techniques. A first user cannot be added to a buddy list of a second user unless the first user provides authorization through a notification request from a second user (Pg. 6, ICQ (I Seek You)). One would be motivated to modify FIBS in view 1MG to add the buddy list membership identifier, to increase system security, and it bars people you don't want to talk to from instant messaging you. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify FIBS in view of 1MG to further add a buddy list membership identifier as part of system software for security purposes.

In re claim 9, FIBS in view of 1MG in view of Tang teach the claimed limitations as
discussed above, where denying authorization to add one to a buddy list is analogous to
a request for deleting that user's name from the buddy list.

In reclaims 10-13 and 46, FIBS in view of 1MG in view of fang teaches the claimed
limitation as discussed above in addition to the chat software contemporaneously with
the game, but does not teach the application stored on a portable memory medium.
However, as is old and well known in the computing arts, storing programs for portability
on optical, magnetic, or semiconductor medium can be accomplished and are all
considered art recognized equivalents. One would be motivated to store the game
program on a portable memory medium for distribution to a wider audience that does
not have high bandwidth network access, often a limitation for downloading large files.
Therefore, it would have been obvious to one of ordinary skill in the art at the time the
invention was made to modify FIBS in view of 1MG in view of Tang to include the game
software on a portable memory medium for greater access by the public, therefore
increasing game participation and distribution.

In re claim 16, FIBS teaches the game used the Internet for communication as
described by the game server title.

In reclaims 17-18 and 34-36, FIBS teaches a user registration routine in the messaging
and game software, where the registration will create a user profile (Pg. 2, Username
and password).

In re claims 20-2 1, Tang teaches the ability to add customized images to a user profile as discussed above.

In re claim~ 22, FIBS teaches having a buddy list routine for creating buddy list as described by the ability to find out who is currently logged on (Pg. 2, Player status).

In re claim 23-24, Tang teaches providing alerts during a sign-on or sign-off event teach as discussed above.

In re claim 28, FIBS teaches the portable memory storage as discussed above, and furthermore teaches the game executed on a computer device. As a computer would typically have inputs for the various memory mediums, it would have been obvious to one of ordinary skill to have connectors connecting the drives that read the memory medium to the computer for necessary read/write operations.

In re claim 25, FIBS teaches an alert when a message arrives, as the message itself is the alert, for example, when inviting a player to a game or chaffing (Pg 2, Player status, Chatting).

In re claims 26, and 3 7-38, FIBS in view of 1MG in view of Tang teach the claimed limitations as discussed above, but does not teach an auto start and auto logging routine for the game program. 1MG teaches an auto-start and logging routine when starting a users computer (Pg. 3, The Good and the Bad). One would be motivated to

modify FIBS in view of 1MG in view of Tang to include the auto-start and logging feature

to alleviate a user from manually starting the game/messaging program, where it is

obvious to automate a manual process. Therefore, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to modify FIBS in view of

1MG in view of Tang to include the auto-start and logging feature, to have the game

software program instantly ready for a user to participate, adding increased play time.

In re claim 27, FIBS in view of 1MG in view of Tang teach customizing a message

describing a user's activity as discussed in claim 4, which would also allow a user to log

that particular activity the user is engaged in on the computer system.

In re claims 4 1-43, Tang teaches providing any number of methods of communication

with other users on the system, which are all provided through the application

framework (8:30-64). Prompting a user that another is attempting communication is

inherent to providing the mechanism to communicate.

In re claim 44, Tang teaches a central repository for storing user desired settings

(11:55-12:30).

In re claims 47 and 52; FIBS in view of 1MG in view of Tang by nature require the use

of a storage device for storing instructions for software, else the system would be

inoperable.

In re claim 51, Tang teaches that the communication server supports any number of

communication mediums between system users including video, audio, text, and email
(8:52-64).

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are
moot in view of the new ground(s) of rejection.

Citation of Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's
disclosure. Eck et al '103 discloses a portable gamining machine with messages,
DeLuca '717 discloses a messaging system, LaPorta '536 discloses a two way
messaging system.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in
this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP
§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37
CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE
MONTHS from the mailing date of this action. In the event a first reply is filed within
TWO MONTHS of the mailing date of this final action and the advisory action is not
mailed until after the end of the THREE-MONTH shortened statutory period, then the
shortened statutory period will expire on the date the advisory action is mailed, and any
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Hotaling II whose telephone number is (571) 272 4437. The examiner can normally be reached on Mon-Thurs 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272 3507. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JOHN M. HOTALING, II
PRIMARY EXAMINER

December 15, 2004